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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/717,667 | 11/21/2003 | Andreas Kaszkin | Q78536 | 9058 |

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| EXAMINER | |
|---|---|
| TRUONG, THANHNGA B | |
| ART UNIT | PAPER NUMBER |
| 2435 | |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 10/717,667 | **Applicant(s)** KASZKIN ET AL. | |
|---|---|---|---|
| | **Examiner** Thanhnga B. Truong | **Art Unit** 2435 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 21 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Thanhnga B. Truong/
Primary Examiner, Art Unit 2435

Continuation of 11. does NOT place the application in condition for allowance because:
Applicant has argued that:

Chen discloses encoding and not encrypting a purchase order, PO (col. 4, lines 58 to 67). That is, Chen only discloses converting plain text (purchase order PO) into XML code, i.e., encoding the PO. Chen, however, is unrelated to encyrption i.e., transforming data so that it is unreadable to anyone without a key. In other words, Chen discloses encoding and not encrypting data. One of ordinary skill in the art would not take from Chen's disclosure of encoding any teaching or suggestion regarding the claimed encryption.

Examiner respectfully disagrees with applicant and still maintains that:

Chen's encoding is the same as invention's encryption. Technically speaking, encoding is the process of transforming information from one format into another and encryption transforms information for secrecy. Functionality, they are both the same by transforming information into something that is unreadable. In addition, the specification of the instant application (paragraph [0005], lines 3-5) shows the data packaged in the email can be encrypted and then decrypted again on extraction from the email and prior to being forwarded. It is understood that email is the text message being encrypted before sending/transmitting, which is exactly the same functionality as Chen's encoding for encoding a purchase order.

Besides, Takagi also teaches the encrypting process in column 4, lines 11-45, wherein The first processing means which has been granted the information exchange sends the transmissin data to the first communication means, and the first communication means 1 uses the random number data provided by the random number generation means to encrypt the entered transmission data and sends it to the card terminal. The encrypted data received by the card terminal is entered to the second communication means, and the second communication means uses the random number data received from the IC card to decrypt the entered encrypted data and enters it to the second processing means. The second processing means sends the transmission data to the second communication means, and the second communication means uses the random number data received from the IC card to encrypt the entered data and sends it to the IC card. The encrypted data received by the IC card is entered to the first communication means, and the first communication means uses the random number data provided by the random number generation means to decrypt the entered encrypted data and enters it to the first processing means. Through the repetition of the foregoing processes, the IC card performs the information encryption process and decryption process by using the random number data generated in the IC card for the encryption key and decryption key, and the card terminal performs the information encryption process and decryption process by using the random number data, which is obtained by decrypting the encrypted random number data received from the IC card, for the encryption key and decryption key, thereby performing the information exchange based on the cryptograph between the IC card and card terminal.

Applicant further argues that:

Chen does not disclose process devices exchanging some but less than all data in the encrypted form, thereby determining by hard wiring or programming which of transmission data are to be encrypted and recognizing which of reception data are encrypted and have to be decrypted. In other words, Chen is unrelated to encrypting only some of the transmitted data and having a device that will analyze the received data and distinguish between encrypted and unencrypted data in these received data. In short, Chen does not disclose or suggest identifying which of the received data needs to be encrypted.

Examiner respectfully disagrees with applicant and still maintains that:

Chen teaches a system for exchanging and merging messages over a network includes a server accessible by a plurality of remote browsers for transmitting a template including fields for information entry and a business system accessible by the server for generating a return message pursuant to information entered in the template on the browsers. The business system includes a first parser for receiving a message from a browser, the message including information about data characteristics of information entered into the template, and a second parser for receiving information about data characteristics to provide a return template. A merging algorithm is implemented to merge the message with the return template for providing a return message to the browser having portions of the return template with data entered therein (see Figures 5 and 6 and column 1, lines 35-48. Chen further teaches, in the illustrative example shown in FIG. 6, a buyer runs a web server 206. In step 201, a supplier can visit the buyer's web site to view PO's using a standard web browser 207. The supplier may decide to create a corresponding invoice from the received PO by submitting a "prepare invoice" request 202 to the web server. The XML document exchange/merge system 105 on the buyer side is invoked and dynamically generates a partial invoice 202'. The partial invoice in XML format is transmitted over the Internet and displayed on supplier's browser 203. The supplier can edit the partial invoice 204, and submit the completed invoice back to the buyer for record handling or auditing 205.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, (1) although Chen teaches a process automation system, Chen is silent on the capability of showing wherein, in at least a first of the process devices, a communication device determines by hard wiring or programming which of transmission data are encrypted in an encryption device of the first process device, and wherein, in at least a second of the process devices, the communication device recognizes which of reception data are encrypted and decrypts the reception data in a decryption device of

the second process device. On the other hand, Takagi teaches these limitations in Figure 9 and more details in column 1, lines 17-43, column 6, lines 35-45 of Takagi. (2) Although Chen teaches the claimed subject matter and the encoding process, Chen is silent on the capability of showing how the encoding process related to the authentication process. On the other hand, Takagi and Fiszman teaches further comprising a central key administration that registers public encryption keys of the process devices and authenticates the public encryption keys with a private encryption key of the central key administration (column 5, line 20 through column 6, line 12 of Takagi; and column 8, lines 34-40 and column 19, lines 54-59 of Fiszman). Thus, the combination of teaching between Chen, Takagi, and Fiszman is efficient and proper.

Chen, Takagi, and Fiszman do not need to disclose anything over and above the invention as claimed in order to render it unpatentable or anticipate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claimed limitations.

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

For the above reasons, it is believed that the rejections should be sustained.